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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,534	09/01/2006	Guenter Hauke	MERCK-3235	2982
23599 7590 09/30/2008 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER				
GERIDO, DWAN A				
ART UNIT		PAPER NUMBER		
1797				
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09/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,534

**Applicant(s)**

HAUKE ET AL.

**Examiner**

Dwan A. Gerido, Ph.D.

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (US 4,302,480).
3. For claim 6, Fischer teaches a process of adding the covering medium to the cover slip by printing techniques (column 5 lines 61-62). The printing technique of Fischer would be fully capable of applying the covering media with a layer thickness of  $\pm 0.1$ .
4. For claim 8, Fischer teaches applying the covering medium by screen printing. (column 5 line 62).
5. For claim 10, Fischer et al teach a cover slip with a layer thickness ranging between 0.05 - 0.15mm which meets the claim limitation of having a thickness not more than 0.2mm (column 3 lines 37-38).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3, 5, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al., (US 4,302,480) in view of Pickett (US 3,498,860).

10. With regards to claim 1, 2, and 3 Fischer et al teach a cover slip with a layer thickness ranging between 0.05 - 0.15mm (column 3 lines 37-38). Additionally, the MPEP states that "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (See MPEP 2144.05 II A). Fischer et al., do not explicitly teach a cover slip having a layer thickness tolerance layer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

coating of Fischer et al., wherein the layer thickness has a tolerance of  $\pm 0.1$ ,  $\pm 0.05$ , and  $\pm 0.02\text{mm}$  in order to allow for variability wherein the cover slip can be formed more rigid and durable for long term storage. Fischer et al., do not teach a glass cover slip.

Pickett teaches a process of preparing a glass cover slip for microscope slides with a covering medium (column 2 lines 44-45, column 3 lines 6-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cover slip of Fischer et al., in view of Pickett to provide a glass cover slip in order to provide a more rigid protective cover for the specimen sample on the slide.

11. With regards to claim 5, Fischer et al., does not specifically indicate the solids content of the covering medium in the dried state. However, Fischer et al., does teach a covering medium identical to that of the instant application (polyvinylpyrrolidone, column 3 lines 43-44). Because the covering medium of the prior art and the instant application are identical, one of ordinary skill would recognize that the covering mediums would exhibit identical characteristics and properties.

12. With regards to claim 12, Fischer et al., teach Polyvinylpyrrolidone as the covering medium (column 3 lines 43-44).

13. With regards to claim 13, Fischer et al., teach water as a solvent (column 2 lines 12-17).

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al (US 4,302,480) in view of Markovits et al., (US 4,011,350).

15. With regards to claim 7, Fischer et al., teach a cover slip for microscope slides and a covering medium applied to the cover slip (column 3 lines 33-36). Fischer et al., does not teach applying the covering medium with a dispensing needle.

Markovits et al., teach a method of making a microscope slide system in which a dispensing needle is used to apply a reagent to the slide (column 7 line 11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the dispensing needle of Markovits et al., in view of the printing technique of Fischer et al., in order to apply a specific volume of covering medium to an individual cover slip as the volume of covering medium may alter stability of the microscope slide.

16. Claims 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al., (US 4,302,480).

17. With regards to claim 9, Fischer et al., teach a cover slip for microscope slides and a covering medium applied to the cover slip (column 3 lines 33-36). Fischer et al., is silent as to the mechanism in which the cover slips are applied to the slide; however, one of ordinary skill in the art would recognize that the cover slips could be manually applied to the microscope slides in order to cover the specimen placed on the slide.

18. With regards to claim 11, Fischer et al., does not specifically indicate the solids content of the covering medium in the dried state. However, Fischer et al., does teach a covering medium identical to that of the instant application (polyvinylpyrrolidone, column 3 lines 43-44). Because the covering medium of the prior art and the instant application are identical, one of ordinary skill would recognize that the covering mediums would exhibit identical characteristics and properties.

19. With regards to claim 14, Fischer et al., teaches the viscosity of the covering media being 1-1000, and 25-500 centipoise. Fischer et al., also teach a wide range of variation for the colorant/polymer ratio utilized in the coating media (column 4 lines 30-43). Fischer et al., do not

teach the viscosity ranging from 2000 - 4000 mPas. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fischer et al., wherein the viscosity ranges from 2000 – 4000 mPas in order to reduce the amount of additives in the covering media as taught by Fischer et al.

***Response to Arguments***

20. Applicant's arguments with respect to claims 1-3, 5-14 have been considered but are moot in view of the new ground(s) of rejection.

21. Regarding claims 1, 2, 5, 6, and 8 applicant has amended claim 1 to include a glass coverslip which is not anticipated by reference to Fischer et al., (US 4,302,480). However, Fischer et al., in view of Pickett (US 3,498,860) teach the limitations of the amended claims. Applicant's argument pertaining to utilizing coverslips for long term storage is regarded as intended use and is not given patentable weight. In addition, applicant argues that Fischer et al., do not teach a layer thickness tolerance level not more than  $\pm 0.1\text{mm}$ . While Fischer et al., do not explicitly teach a layer thickness tolerance of  $\pm 0.1\text{mm}$ , the claimed tolerance levels are sufficiently broad that one of ordinary skill would have found it obvious to set a thickness tolerance level at  $\pm 0.1\text{mm}$ . Also it is noted that applicant recites thickness being at 0.05 for the lower thickness range while maintaining tolerance levels at  $\pm 0.1\text{mm}$ .

22. Reference to Pickett et al., (US 3,498,860) is utilized to meet the limitation of glass coverslips. Applicant argues the reference to Pickett et al., in terms of adhesive properties; however, the instant claims do not recite limitations regarding adhesive properties.

23. Reference to Markovits et al., teach a method of making a microscope slide system in which a dispensing needle is used to apply a reagent to the slide (column 7 line 11). It is the

examiners position that one of ordinary skill would have found it obvious to utilize the method of Markovits et al., in view of Fischer et al., to apply a coating to coverslips in order to in order to apply a specific volume of covering medium to an individual cover slip as the volume of covering medium may alter stability of the microscope slide.

***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwan A. Gerido, Ph.D. whose telephone number is (571)270-3714. The examiner can normally be reached on Monday - Friday, 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/  
Primary Examiner, Art Unit 1797  
DAG